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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,930	01/26/2001	Wayne L. Pushka	24,757 USA)	8224

7590 02/20/2007  
Mark D. Simpson, Esq.  
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EXAMINER
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HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3691

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/770,930

Applicant(s)

PUSHKA, WAYNE L.

Examiner

Lalita M. Hamilton

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### Summary

On December 27, 2005, the Applicant filed an after-final amendment. On February 13, 2006, an advisory action was sent to the Applicant reopening prosecution. A non-final follows.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Hackel (5,806,047).

Hackel discloses a method and corresponding system and computer readable medium for a combined pool portfolio comprising optimizing investment performance of an economic entity, providing on an investment date, a first account in a first regulatory environment, the first account owning an investment portfolio, providing a second account in a second regulatory environment, transferring market risk but not credit risk from the first account to the second account through a counterparty, and recognizing one of gains and losses in said second account at a future date from the investment date (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56); transferring market risk but not credit risk from the first account to the second account through a counterparty is accomplished by entering into a first derivative transaction between the first account

Art Unit: 3691

and a first counterparty whereby market risk is transferred to the first counterparty, and entering into a second derivative transaction between the second account and a second counterparty whereby market risk is transferred to the second account from the second counterparty (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56); the first counterparty and the second counterparty are separate counterparties (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56); the first counterparty and the second counterparty are the same counterparty (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56); the derivative transaction between the first account and the counterparty is carried out through an intermediary (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56); the intermediary is a counterparty selected from the group consisting services company, a trust, a limited partnership, an organization that issues securities and enters into derivative contract agreements and an organization that manages funds on behalf of a third party of a fund manager, a bank, a mutual fund, and a financial institution (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56); transaction is guaranteed by a third party guarantor (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56); the first derivative transaction is selected from the group consisting of a forward contract, an option contract, a collar contract and a derivative contract that transfers market risk (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56); the second derivative transaction is selected from the group consisting of a forward contract, an option contract, a collar contract and a derivative contract that transfers market risk (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56); the counterparty is selected from the group fund, a financial services company, a trust, a limited consisting of a bank, a

Art Unit: 3691

mutual fund, partnership, an organization that issues securities and enters into derivative contract agreements and an organization that manages funds on behalf of a third party (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56); first account owns the investment portfolio indirectly through the ownership of an investment unit (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56); the future date from the investment date is at least one year (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56); first and second derivative transactions are reverse transactions (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56); a data processing system for managing the investment performance of an economic entity having a first account in a first regulatory environment and a second account in a second regulatory environment, said first account having an investment portfolio on an investment date, the system comprising a data processor for processing data relating to a transfer of market risk but not credit risk from the first account to the second account through a counterparty and a computer for storing data relating to assets in the first and second accounts and calculating one of gains and losses in the value of assets in said second account at a future date from the investment date (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56); and a computer readable storage medium containing computer executable code for instructing a computer to operate for storing data relating to a first account in a first regulatory environment, the first on an investment date, account owning an investment portfolio on an investment date, storing data relating to a second account in a second regulatory environment, processing data relating to a first derivative transaction between the first account and a first counterparty whereby market risk is

Art Unit: 3691

transferred to the first counterparty, processing data relating to a second derivative transaction between the second account and a second counterparty whereby market risk is transferred to the second account from the second counterparty, and calculating one of gains and losses in said second account at a future date from the investment date (col.2, lines 15-53; col.3, lines 1-11; and col.5, lines 5-56).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

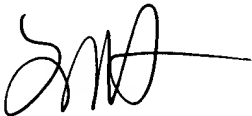
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kalinowski Alexander can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Lalita M. Hamilton  
Primary Examiner, 3691